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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,570	12/05/2001	Ruby Mercado	1001.300	6659

7590

01/28/2004

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EXAMINER

WEAVER, SUE A

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/008,570

Applicant(s)

MERCADO ET AL.

Examiner

Sue A. Weaver

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 7-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 11-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the Philippines on 12/5/01. It is noted, however, that applicant still has not filed a certified copy of the Philippine application as required by 35 U.S.C. 119(b). Claims 7-10 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.
3. The proposed drawings corrections were received on 11/14/03. These proposed corrections are approved.
4. The objection to the disclosure made in paragraph 6 of the previous Office action Paper No. 9 is withdrawn in view of applicant's amendment received 11/14/03.
5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "the sides are removed" in lines 5 and 6. There is insufficient antecedent basis for this limitation in the claim.

Other than a bag body, and openable portion, a handle and rigidifying members, there isn't any other construction set forth for the bag in claim 11 to establish "the sides" which are removable.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 3727

6. Claims 11, 14, 16 and 19, insofar as they are definite are, rejected under 35 U.S.C. 102(b) as anticipated by Johnson '818, for the reason set forth in paragraph 7 of the previous Office action, Paper No. 9.

7. Claims 11, 12, 16 and 17, insofar as they are definite remain rejected under 35 U.S.C. 102(b) as being anticipated by Weiner for the reasons set forth on paragraph 8 of the previous Office action.

8. Claims 1, 2, 5, 15 and 20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Sher (4,589,530) for the reasons set forth in paragraph 9 of the previous Office action.

Note the removable bottom panel of Sher at 9 in a collapsible bag (see Figure 4) with wheels.

9. Claim 3 remains rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Lichtwardt et al in the manner set forth in paragraph 10 of the previous Office action.

10. Claim 4 remains rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 3 above, and further in view of Simonett et al for the reasons set forth in paragraph 11 of the previous Office action.

11. Claim 6 remains rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Hurwitz for the reasons set forth in paragraph 12 of the previous Office action.

12. Claims 13 and 18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 11 and 16 above, and further in view of Pelky et al for the reasons set forth in paragraph 13 of the previous Office action.

13. Claim 21 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Wisniewska in view of Lichtwardt et al for the reasons set forth in paragraph 14 of the previous Office action.

14. Claim 22 remains rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 21 above, and further in view of Simonett et al for the reasons set forth in paragraph 15 of the previous Office action.

15. Applicant's arguments filed 11/14/03 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a complete set of removable panel" (paragraph a) "removal of all the inserts" and "providing flexible fouling walls on all corners" (paragraph b) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In paragraph c applicant appears to be arguing the wrong reference. It is Sher US 4590530 provided with applicant's references but cited with the wrong patent number, which is relied upon to teach the provision of a removable bottom panel on collapsible luggage with wheels. To have merely provided Johnson with such a removable bottom panel so that the luggage might be further collapsed would have

Art Unit: 3727

been obvious in view of such teach by Sher at 9. Sher will be properly cited in the attached PTO 892.

In response to applicant's argument that it would not have been obvious to combine Lichtwardt (paragraph d) Pelky et al (paragraph g) or Wisniewska, (paragraph h) the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Lichtwardt et al is merely relied upon to show that bags with handle which have a cubic shape are known in the art. Therefore it is merely relied upon to show the known bag shape not any other construction as that is already taught. Pelky et al is relied upon to show the provision of separate feature which does not rely on any particular bag construction for its operability. Transparent pockets are known in bags with handles as shown by Pelky et al and the inclusion of such in a bag to display the contents would have been most obvious. It does not destroy the primary reference to provide it with an additional pocket. Wisniewska teaches the collapsible bag construction with strap handles. To have merely changed the shape of the bag to a shape shown as already known would not have affected the function of the bag and would have been obvious in view of the references of record.

Claims 1-6, and 11-22 remain rejected while claims 7-10 remain withdrawn.

The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with

Art Unit: 3727

all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

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on _____
(Date)

Typed or printed name of person signing this certificate:

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Art Unit: 3727

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Weaver whose telephone number is (703) 308-1186. The examiner can normally be reached on Tuesday-Friday.

— The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3579.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


Sue A. Weaver
Primary Examiner

SW